

REMARKS

The Restriction Requirement:

Applicants affirm the election without traverse of Invention I (claims 1-7, 36-42 and 48-52) made by Koren Anderson on June 8, 2006. Claims 8-35 and 43-47 are withdrawn from consideration as being drawn to a non-elected invention.

The Amendment:

Claims 8-35 and 43-47 are canceled by this amendment. Claims 53-56 are newly added. Claims 1-3, 5-7, 36, 39, 40, 49 and 50 are currently amended. The amendments do not add new matter and are fully supported by the application as filed, in particular, the claims as filed, as well as page 37, lines 5-15 of the specification.

The amendments merely involve formalities, grammatical oversights/preferences, typological errors, and the like. These amendments to the claims are made solely to obtain expeditious allowance of the instant application.

Amendment of the claims is made without prejudice, without intent to abandon any originally claimed subject matter, and without intent to acquiesce in any rejection of record. Applicant expressly reserves the right to file one or more continuing applications hereof containing the canceled or unamended claims. Entry of the claim amendments is respectfully requested.

The Office Action:

Claims 3, 5, 6, 39, 40, 49 and 50 are rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite.

Claims 1-5, 36-39 and 42 are rejected under 35 U.S.C. § 102(b) as being anticipated by Majima et al., 1243 Biochim. Biophys. Acta 336 (1995).

Claims 1-4, 6-7, 36-42 and 48-52 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lomas, U.S. Patent Publication No. 2003/0077616.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph:

Claims 3, 5, 6, 39, 40, 49 and 50 are rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In view of the current amendment Applicants believe that this rejection has been rendered moot. Accordingly, withdrawal of the rejection under 35 U.S.C. § 112, 2nd paragraph is respectfully requested.

Rejection Under 35 U.S.C. § 102:

I. Claims 1-5, 36-39 and 42 are rejected under 35 U.S.C. § 102(b) as being anticipated by Majima et al., 1243 Biochim. Biophys. Acta 336 (1995). In view of the amendments and the following remarks, Applicants respectfully traverse this rejection.

According to the Office Action, Majima describes a fluorescent compound (EMA) and a buffer (phosphate buffer). As amended, claim 1 is directed to a fluorescent compound capable of selectively binding to a poly-histidine, poly-arginine or Glu-Glu affinity tag and a buffer. Majima fails to describe a fluorescent compound capable of selectively binding to a poly-histidine, poly-arginine or Glu-Glu affinity tag. Claims 2-5 include the limitations of claim 1 and are thus distinct from Majima as well.

With respect to claims 36-39, the kit of claim 36 is for detecting an affinity tag containing fusion protein, and said kit includes instructions for the detection of the affinity tag containing fusion protein. Majima does not suggest that the EMA compound could be used for detection of an affinity tag containing fusion protein and certainly does not include instructions thereto.

New claim 53 provides a staining solution comprising a fluorescent compound capable of binding to an affinity tag and a buffer comprising a metal ion. Majima describes a phosphate buffer, not one comprising a metal ion.

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.

Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675. Since Majima does not teach every element of the present claims there is no anticipation. Accordingly, applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be withdrawn.

II. Claims 1-4, 6-7, 36-42 and 48-52 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lomas (U.S. Patent Publication No. 2003/0077616). In view of the following, Applicants respectfully traverse this rejection.

According to the Office Action, Lomas describes a fluorescent compound (fluorescein) and a buffer. As amended, claim 1 is directed to a fluorescent compound capable of selectively binding to a poly-histidine, poly-arginine or Glu-Glu affinity tag and a buffer. Lomas fails to describe a fluorescent compound capable of selectively binding to a poly-histidine, poly-arginine or Glu-Glu affinity tag. Claims 2-4 and 6-7 include the limitations of claim 1 and are thus distinct from Lomas as well.

Furthermore, Lomas describes fluorescein as a potential affinity label that can be detected by a capture antibody (see Table 1). Accordingly, fluorescein is the affinity tag and the binding agent for detection of the affinity tag is an anti-fluorescein antibody. Applicants are claiming a binding agent that is fluorescent and not an antibody. Conversely, the binding agent in Lomas is not fluorescent and is an antibody.

Accordingly, the present claims are clearly different from what is being disclosed in Lomas. For these reasons claims 1-4, 6-7, 36-42 and 48-52 are not anticipated by Lomas. Withdrawal of the rejection under 35 U.S.C. § 102(e) is respectfully requested.

CONCLUSION

In view of the amendment and remarks, it is submitted that this application is now ready for allowance. Early notice to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent at (541) 335-0165.

Respectfully submitted,

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